

REMARKS

Claims 1, 2, 4-18, 20, and 21 were pending. The applicants amend claim 1, cancel claim 21, and add new claim 22. Claims 1, 2, 4-18, 20, and 22 are submitted for examination in view of the amendments and following remarks.

Claims 1, 2, 5-18, and 20 were rejected under 35 U.S.C. 103(1) as being unpatentable over U.S. Pat. No. 6,355,946 ("Ishinaga"), in view of U.S. Pat. No. 6,707,069 ("Song"), alone or in further view of U.S. Publ. No. 2003/0189830 ("Sugimoto") or U.S. Publ. No. 2003/0230751 ("Harada").

Claim 1 recites "a reflector body [that] comprises a ceramic ... wherein the reflector body is coated with the reflector material." The examiner concedes that Ishinaga

does not teach that the reflector body comprises a ceramic.

Although the examiner asserts that

Song teaches a reflector body comprising ceramic (Fig. 3, 102 or Fig. 4a, 152 and Col 5 Ln 58-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the reflector body 52 of Ishinaga from ceramic as taught by Song in order to improve the heat dissipation in the device (Col 3 Ln 24).

the proposed combination of Ishinaga and Song is inappropriate. Song describes a ceramic substrate 102 with a cavity into which a reflective metal plate 120 is inserted.¹ However, Song proposes the use of the reflective metal plate because "it is almost impossible to form a desired reflecting surface on the ceramic body" by coating a metal layer onto the inside surfaces of the ceramic body.² Thus, Song teaches away from the modification of Ishinaga proposed by the examiner³ and the proposed combination of Ishinaga and Song is inappropriate.⁴ For at least these reasons, the examiner's articulated reason for modifying Ishingaga lacks the rational underpinning necessary to support the legal conclusion of obviousness.⁵

¹ See, e.g., Song, col. 5, line 48 - col. 6, line 13.

² See Song, col. 2, lines 48-60.

³ *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 USPQ2d 1923 (CAFC 1990) (A reference teaches away if it "would likely discourage the art worker from attempting the substitution suggested by [the inventor/patentee].").

⁴ See, e.g., *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (It is improper to combine references where the references teach away from their combination.).

⁵ See *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727 at 1740 (2007) citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements;

Neither Sugimoto nor Harada has been shown the remedy the deficiencies of the proposed combination of Ishinaga and Song. Accordingly, the applicants request that the rejection of claims 1, 2, 5-18, and 20 were rejected under 35 U.S.C. 103(1) as being unpatentable over Ishinaga, in view of Song, alone or in further view of Sugimoto or Harada be withdrawn.

The pending office action does not present any rejections of claim 4.⁶ Therefore, the applicants rewrite claim 4 in independent form. The applicants also include the feature that “the reflector body is coated with the reflector material” in new claim 21. Therefore, claim 21 is patentable for at least the same reasons as claim 1. Moreover, claim 21 includes the features of claims which was not rejected in the pending office action.

All of the dependent claims are patentable for at least similar reasons as those for the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicants have (a) addressed certain comments of the examiner does not mean that the applicants concede other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicants concede any of the examiner's positions with respect to that claim or other claims.

instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” – emphasis added).

⁶ The applicants note that the “Disposition of Claims” section of the “Office Action Summary” lists claims 1, 2, 4-18, 20, and 21 as rejected.

Applicant : Herbert Brunner et al.
Serial No. : 10/593,794
Filed : March 13, 2007
Page : 7 of 7

Attorney's Docket No.: 12406-0216US1 / P2004,0241
US N

The fees in the amount of \$810 for a Request for Continued Examination are being paid concurrently herewith on the Electronic Filing System by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 12406-216US1.

Respectfully submitted,

Date: March 2, 2009



Sean M. Dean, Ph.D., J.D.
Reg. No. 46,656

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (877) 769-7945